

## **REMARKS:**

Claims 36-51 are presented for examination, with claims 1-35 having been cancelled.

### **Claim Objections**

First, in the Office Action, the Examiner has objected to claims 40-43 as being “a substantial duplicate of claims 36-39.” Applicant respectfully disagrees with the Examiner. Claim 40 is an independent claim, and claims 41 thru 43 depend from claim 40. Similarly, Claim 36 is an independent claim, and claims 37 thru 39 depend from claim 36. The order of claim steps in Claim 40 differs from the order of claim steps in Claim 39. For example, claim 39 requires:

A computer implemented method for use in connection with a transaction with a security, which method comprises the steps of:

storing at least a first and second security documents on a document storage database of a computer, wherein each security document describes a security, and wherein each security document comprises of a plurality of parts, wherein each part of the plurality of parts is associated with an identifier;

receiving a first transaction record with information regarding an ownership of at least one security by an investor from a computer, wherein the first transaction record comprises of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by the investor;

mapping with a computer at least one part of the plurality of parts of the first transaction record to at least a first identifier; ...”

In contrast, claim 40 requires:

“A computer implemented method for use in connection with a transaction with a security, which method comprises the steps of:

storing at least a first and second security documents on a document storage database of a computer, wherein each security document describes a security, and wherein each security document comprises of a plurality of parts, wherein each part of the plurality of parts is associated with an identifier;

receiving a first transaction record with information regarding an ownership of at least one security by an investor from a computer, wherein the first transaction record comprises of a plurality of parts wherein each of the plurality of parts

contains information related to ownership of the at least one security by the investor;

receiving a second transaction record with information regarding an ownership of at least one security by the investor from a computer, wherein the second transaction record comprises of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by the investor;

mapping with a computer at least one part of the plurality of parts of the first transaction record to at least a first identifier ...”

Therefore, claim 39 and claim 40 are not duplicate of each other. Accordingly, claims 41 thru 43 which depend from claim 41 are not duplicate of claim 37 thru 39.

Second, in the Office Action, the Examiner has objected to claims 48-51 as being “a substantial duplicate of claims 44-47.” Applicant respectfully disagrees with the Examiner. Claim 48 is an independent claim, and claims 49 thru 51 depend from claim 48. Similarly, Claim 44 is an independent claim, and claims 45 thru 47 depend from claim 44. The order of claim steps in Claim 48 differs from the order of claim steps in Claim 44. For example, claim 44 requires:

“a computer processor operatively connected with the document storage database and the transaction database, wherein the computer processor  
stores at least a first and second security documents on the document storage database;  
receives a first transaction record from the transaction database with information regarding an ownership of at least one security by the investor;  
maps at least one part of the plurality of parts of the first transaction record to at least a first identifier ...”

In contrast, claim 48 requires:

“a computer processor operatively connected with the document storage database and the transaction database, wherein the processor  
stores at least a first and second security documents on the document storage database;  
receives a first transaction record from the transaction database with information regarding an ownership of at least one security by the investor;  
receives a second transaction record from the transaction database with information regarding an ownership of at least one security by the investor;

maps at least one part of the plurality of parts of the first transaction record to at least a first identifier ...”

Therefore, claim 44 and claim 48 are not duplicate of each other. Accordingly, claims 49 thru 51 which depend from claim 48 are not duplicate of claim 45 thru 47.

**Claim Rejection Under 35 USC § 112**

In the Office Action, the Examiner has rejected claims 36 thru 51 for not complying with the written description requirement with respect to the following terms which are listed in the table below along with exemplary citations to the original specification which provide support for these following terms, as would be viewed by an ordinary person skilled in the art when the application was filed:

Term	Exemplary Support Citation
1. Transaction Record	“[0072] If it is determined at step 202 that this is an investor's first time purchase of the fund, at step 203 the system examines previous purchases to determine if the investor had previously bought funds from the same fund family as the family to which the current fund belongs. If the system determines at step 203 that the investor has never previously purchased a fund from the same find family, <u>the system records that Part A 207 is required for this transaction.</u> ” ( <i>Emphasis added</i> )
2. Security Document	“[0033] As will be clear to those of skill in the art, the present invention can be used to prepare and disseminate any custom <u>document(s)</u> that must be provided to an investor. For exemplary purposes, the following discussion describes embodiments of the present invention directed toward the delivery of compliance information related to the purchase of one or more <u>mutual funds</u> . Following this discussion is a broader example of the present invention describing

	<p>the provision of generic compliance information, such as quarterly reports, for a <u>stock</u> purchase.</p> <p>[0034] One skilled in the art will appreciate that sending an investor information about a purchased <u>security or mutual fund security</u> entails complying with several laws and/or regulations that may differ from jurisdiction to jurisdiction.”</p>
3. First Identifier	<p>“[0083] At step 309, each document part identified by segmentation step 308 is associated with <u>an identifier</u> used in the daily transactions.” (<i>Emphasis added</i>)</p>
4. Second Identifier	<p>Please see above for the “First Identifier”</p>

### **Claim Rejection Under 35 USC § 101**

In the Office action, the examiner has rejected claims 36 thru 43 as being non-statutory because “[t]he process steps in claim (36-43) are not tied to another statutory class nor do they execute a transformation.” Office Action at 4. The applicant respectfully disagree with the Examiner’s opinion. However, for purposes of advancing the examination, the applicant has amended the independent claims 36 and 40 to highlight that at least some steps of these claims are performed using a computer. Since all rejected dependent claims depend from claims 36 and 40, respectively, therefore, this rejection is rendered moot with respect to all claims 36 thru 43.

### **Claim Rejection Under 35 USC § 103**

In the Office action, the examiner has rejected claims 36 thru 51 over Levering et. al. (“Levering”), in view of website [www.tdcanadatrust.com](http://www.tdcanadatrust.com) (“TD Canada Trust”), Ref. U. With respect to claim 36, the Examiner acknowledges that Levering does not explicitly disclose, suggest or teach all imitations of the claimed invention. Specifically, the Examiner states that TD Canada Trust “teaches selecting the second part

of the second security document; selecting the first part of the first security document and combining the selected first part of the security document and the selected second part of the second security document in to an investor document (see Ref. U on top of page 3). TD Canada Trust shows how an investor or user can easily select and download Part A and/or Part B of a mutual fund prospectus.” Office Action at 6-7. Thus, first, the Examiner acknowledges that TD Canada Trust reference relies on the action by an user, or investor, to determine what appropriate security documents he or she needs. Whereas, the claimed invention at least requires the limitation of “selecting with a computer, if the investor did not receive the first part, the first part of the first security document.” Therefore, TD Canada Trust actually teaches away from the claimed invention which serves to eliminate potential mistakes and regulatory non-compliance issues on the part of a financial institution by delivering to the investor the appropriate security documents, and thus eliminating the guessing aspect which is associated with TD Canada Trust.

Second, TD Canada Trust further does not disclose, teach, or suggest how to “combining with a computer the selected first part of the first security document and the selected second part of the second security document into an investor document.” Further, as for example the choice “Money Market Funds” in the second column on page 3 of TD Canada Trust represents that each file in the second column contains information for more than one specific fund.

Therefore, the Examiner has not met the burden of showing *prima facie* obviousness to combine Levering and TD Canada Trust, by a person of ordinary skill in the art at the time of the claimed invention.

Further, as detailed above, since the combination of Levering and TD Canada Trust

does not disclose, teach or suggest the specific limitations of claim 36, subsequently, the combination does not make dependent claims 37-39 obvious.

Further, for the same reasons, as expressed above, the Examiner's rejection based on the combination of Levering and TD Canada Trust is respectfully traversed with respect to claims 40 thru 51.

Therefore, the Examiner's rejection under 35 U.S.C. §103 (a) is moot, and or the reconsideration of the Examiner's position with respect to Levering reference in view of TD Canada Trust is earnestly sought.

### **Conclusion**

Accordingly, it is respectfully submitted that the rejections raised by the Examiner in the July 31, 2008 Office Action have been overcome and or rendered moot and that the above-identified application is now in condition for allowance.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,  
GREENBERG TRAURIG, LLP

Dated: February 2, 2009

By: /barry j schindler/  
Barry J. Schindler  
Registration No. 32,938

Mailing Address:  
GREENBERG TRAURIG, LLP  
MetLife Building  
200 Park Avenue  
New York, NY 10166  
Telephone: (212) 801-2100  
Facsimile: (212) 801-6400